

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-14 and 21-22 remain in the application. Claim 1 has been amended. Claims 15-20 have been cancelled.

The Examiner has stated in the Advisory action dated May 6, 2005 that it is not understood how the redeposition of the first conductive material (6) is formed by the second conductive material (7) during the overetching, while the first material is exposed to the etchant during the overetching. However, claim 1 of the instant application clearly recites that the redeposition of the first conductive material is not formed but prevented by the second conductive material. The language of claim 1 has been modified in an effort to even more clearly define the invention of the instant application and to avoid any confusion.

As already discussed in the previous response, in the invention of the instant application the breaking through of the electrode configuration, which is caused during the overetching of the electrode configuration due to the different depths of the contact holes, is prevented by the second conductive layer (7).

In Watabe the electrode 10 at the bottom of the contact hole 22 is prevented from being broken through by controlling the etching rate by changing the size (diameter) of the contact holes 20, 22. Nowhere does Watabe disclose or suggest preventing the breaking through of the electrode by applying a second conductive layer (titanium nitride) on a first conductive layer (platinum) during overetching of the electrode configuration due to the different depths of the contact holes.

In contrast, in the invention of the instant application, the breaking through of the electrode configuration is prevented by the second conductive layer, not by adjusting the size of the contact holes.

Although Schuele et al. disclose a titanium nitride layer, it is not disclosed or suggested anywhere in Schuele et al. that the titanium nitride layer can prevent breaking through of the electrode during overetching of the electrode configuration due to the different depths of the contact holes because Schuele et al. do not disclose forming contact holes of different depths.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Schuele et al. to

incorporate the features of forming at least two contact holes with different depths and preventing, by the second conductive layer, breaking through of the electrode configuration and formation of redeposition of the material of the first conductive layer during the overetching, and there is no teaching or suggestion in Watabe to incorporate the features of forming a second conductive layer of the electrode configuration on the first conductive layer from a material etchable by chemical dry-etching and preventing, by the second conductive layer, breaking through of the electrode configuration and formation of redeposition of the material of the first conductive layer during the overetching.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the Applicants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825

(1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Schuele et al. or Watabe or to combine Schuele et al.'s and Watabe's teachings to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Schuele et al. or Watabe or from knowledge available to those skilled in the art.


Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

In view of the foregoing, reconsideration and allowance of claims 1-14 and 21-22 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to 37 CFR Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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